

Remarks

Introduction

Claims 1-43 were pending. By way of this response, claims, 1, 11, 23 and 31 have been amended, claim 24 has been cancelled without prejudice, and claims 44-51 have been added. Independent claims 1, 11, 23, and 31 have been amended to recite that the present contact lenses comprise a cast-molded contact lens body. Claim 23 has further been amended to include the subject matter of claim 24. Support for the amendments to the claims can be found in the specification as originally filed. For example, support for cast-molded contact lenses can be found at least at page 9, line 6 to page 10, line 28. Support for the new claims can at least be found at page 14, lines 15-16; and page 18, line 6. Accordingly, claims 1-23 and 25-51 are currently pending.

In view of the amendments to the claims and the remarks herein, applicant respectfully requests reconsideration and withdrawal of each of the claim rejections.

Rejections Under 35 U.S.C. § 103

Claims 23 and 26-29 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable by Lieberman (U.S. Pat. No. 5,880,809). Claims 1-9, 11-21, 24-25, and 31-42 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lieberman in view of Baba et al. (US 20040039077; hereinafter Baba). Claims 11-15 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Townsley (U.S. Pat. No. 5,020,898) in view of Baba.

Applicant traverses each of these rejections as it relates to the present claims.

Applicant maintains the previous remarks and submits the following to support the patentability of the present claims.

Regarding the rejection of claims 23 and 26-29, claim 23 has been amended to include the subject matter of claim 24 and claim 24 has been cancelled.

In view of the above, applicant submits that the present claims, and claims 23 and 26-29 in particular, are unobvious from and patentable over Lieberman under 35 U.S.C. § 103.

Regarding the rejections of the claims over Lieberman in view of Baba, and Townsley in view of Baba, applicant submits that the combinations of references do not disclose, teach, or suggest the presently claimed invention, and that a person of ordinary skill in the art would not be motivated to combine the teachings of the references, let alone to do so and obtain the present invention. Therefore, applicant submits that a *prima facie* case of obviousness has not been established.

For example, applicant submits that the combination of Lieberman and Baba, and the combination of Townsley and Baba do not teach or provide an enabling disclosure of contact lenses which comprise a cast-molded lens body in combination with the other features of the present claims. In addition, applicant submits that a person of ordinary skill in the art would not be motivated to combine the teachings of Lieberman and Baba or the teachings of Townsley and Baba since the references are directed to solving different problems, do not include a motivation or even a suggestion to combine the teachings, and actually lead a person of ordinary skill in the art away from the presently claimed invention.

Lieberman discloses soft, hard, or gas-permeable contact lenses. The only disclosure of silicon-containing contact lenses in Lieberman is of rigid gas permeable lenses, which are

different and distinct from the contact lenses recited in the present claims. In addition, Lieberman specifically discloses contact lenses that are lathed from lens blanks (e.g., see column 12, line 52 to column 13, line 21). Lieberman does not include any disclosure, teaching, or suggestion of contact lenses comprising cast-molded lens bodies. Lieberman is directed to providing better fitting contact lenses which have design features to accommodate a natural tilt of a cornea of an eye (column 2, line 53 to column 3, line 22). Lieberman is not concerned with addressing problems of different contact lens materials, such as the lens materials recited in the present claims.

Townsley discloses contact lenses that can be formed of materials such as hydroxyethylmethacrylate, metalloorganic substances, silicone rubbers, and materials described in U.S. Pat. Nos. 3,503,942 and 3,639,524 and which are cut to include the desired design features (see column 4, lines 19-37). The only reference to a silicone material for the contact lenses disclosed by Townsley is to silicone rubber contact lenses. Silicone rubber contact lenses and hydrophilic silicone polymer containing lenses are different and distinct, one from the other. Townsley does not teach or provide an enabling disclosure for contact lenses comprising molded lens bodies that include the design features disclosed therein. In addition, Townsley attempts to provide contact lenses with certain design features such as a thickened lower portion to improve the physical fit of the lens on the eye of a patient. Townsley is not concerned with addressing problems of different contact lens materials, such as the lens materials recited in the present claims.

Baba discloses a new ocular lens material. More specifically, Baba is directed to new ocular lens materials which can be produced with less complicated methods than those of the prior art (paragraph [0008]). Baba does not disclose any surface or lens body features of the contact lenses produced by the new ocular lens material.

As discussed herein, applicant submits that the combinations of Lieberman and Baba, and Townsley and Baba do not disclose, teach, or suggest the present invention. For example, the combinations of references do not teach a contact lens which comprises a cast-molded lens body including a silicone hydrogel or a hydrophilic silicone polymer component and that has a surface with a varied surface topography with at least one contour that defines a substantially junctionless varying radial thickness, as recited in the present claims.

The two primary references (Lieberman and Townsley) only provide an enabling disclosure for contact lenses which include lathed lens bodies or cut lens bodies. The two primary references do not provide an enabling disclosure of contact lenses that comprise cast-molded lens bodies, as recited in the present claims. Thus, applicant submits that the primary references do not disclose, teach, or even suggest the present invention.

The secondary reference (Baba) discloses contact lenses of new ocular lens materials without any of the physical features recited in the present claims. Thus, applicant submits that Baba does not provide an enabling disclosure of a contact lens that comprises a lens body that has a surface with a varied surface topography with at least one contour that defines a substantially junctionless varying radial thickness, as recited in the present claims.

Applicant submits that since none of the cited references provides an enabling disclosure for the presently claimed contact lenses, the combinations of references do not teach or even suggest the present invention.

In addition, applicant submits that a person of ordinary skill in the art would not be motivated to combine the teachings of Lieberman, or the teachings of Townsley, with the teachings of Baba, let alone to do so and obtain the presently claimed invention.

Applicant submits that Lieberman and Townsley are directed to solving different and distinct problems than the problems to which Baba is directed. For example, Lieberman and Townsley are directed to better fitting contact lenses with certain physical feature characteristics and not contact lens materials. In contrast, Baba is directed to providing new ocular lens materials and not providing different contact lens designs or physical configurations. Thus, applicant submits that a person of ordinary skill in the art, given the teachings of Lieberman or Townsley, would not be motivated to use, let alone combine, the teachings of a reference, such as Baba, that is directed to a completely different and distinct problem from the problem addressed by Lieberman and Townsley with Lieberman and Townsley. This lack of a motivation is particularly clear since Baba is silent to any physical features of contact lenses that address the problems disclosed by Lieberman and Townsley.

Furthermore, applicant submits that a person of ordinary skill in the art would not be motivated to combine the teachings of Lieberman, or Townsley, and Baba and obtain the presently claimed invention since Lieberman and Townsley actually teach contact lenses with non-cast-molded lens bodies. In short, Lieberman and Townsley teach away from contact lenses that

comprise a cast-molded lens body, as recited in the present claims. "As a general rule, references that teach away cannot serve to create a prima facie case of obviousness." (*McGinley v. Franklin Sports, Inc.* CAFC 8/21/01 citing *In re Gurley*, 31 USPQ2d 1131, (Fed. Cir. 1994)).

As discussed herein, Lieberman specifically discloses contact lenses that comprise lathed lens bodies. Lieberman is silent to any other type of lens body, including a cast-molded lens body. In fact, Lieberman repeatedly emphasizes that lathed lens bodies are preferred. Similarly, Townsley specifically discloses contact lenses that comprise cut lens bodies. In particular, Townsley discloses that cutting is necessary to cut a concentric trim and to cut the lower portion of the carrier of the lens (column 4, lines 21-33). Thus, applicant submits that given the teachings of Lieberman and Townsley, a person of ordinary skill in the art would not be motivated to form a cast-molded lens body that includes a silicone hydrogel or a hydrophilic silicone polymer component and that has a surface with a varied surface topography with at least one contour that defines a substantially junctionless varying radial thickness, as recited in the present claims.

In view of the above, applicant submits that the present claims, and claims 1-9, 11-21, 24-25, and 31-42 in particular, are unobvious from and patentable over Lieberman, Townsley, and Baba, taken alone or in any combination, under 35 U.S.C. § 103.

In addition, each of the other present dependent claims is separately patentable over the prior art. For example, none of the prior art disclose, teach, or even suggest the present contact lenses including the additional feature or features recited in any of the present dependent claims. Therefore,

applicant submits that each of the present claims is separately patentable over the prior art.

Conclusion

In conclusion, applicant has shown that the present claims are unobvious from and patentable over the prior art under 35 U.S.C. § 103. Therefore, applicant submits that the present claims, that is claims 1-23 and 25-51 are allowable. Therefore, applicant respectfully requests the Examiner to pass the above-identified application to issuance at an early date. Should any matters remain unresolved, the Examiner is requested to call (collect) applicant's attorney at the telephone number given below.

Date: _____

12/20/05

Respectfully submitted,



Frank J. Uxa
Attorney for Applicant
Registration No. 25,612
4 Venture, Suite 300
Irvine, California 92618
(949) 450-1750
(949) 450-1764 Facsimile